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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,447	09/13/2000	Helen B. McIntosh	T2739-906589	7855
181	7590	06/30/2004	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/661,447	MCINTOSH, HELEN B.	
Examiner	Art Unit		
Dmitry Suhol	3712		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 May 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 24-33 and 35-37 is/are pending in the application.  
4a) Of the above claim(s) 28-31 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 24-27, 32-33 and 35-37 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24, 26, 27, 32 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Sherin '106. Sherin discloses a kit containing all of the elements of the claims including a set of instructions including a script having a plurality of phrases where each phrase corresponds to a beginning of a respective statement (instructions 14, 16, 18, 20, 24, 26 and 28, a script col. 3, lines 50+ and col. 4, lines 25-30) as required by claims 24 and 32, a portable object (puzzle pieces described in col. 2, line 45) as required by claims 24 and 32, a package/container (package 12) as required by claims 24 and 32. A portable object being a sheet, as required by claims 26 and 36, is read onto the sheet puzzle pieces as shown in figures 1 and 2. The package being portable, as required by claims 27 and 32, is shown in figure 1 as element 12.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25, 33, 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherin '106. Although Sherin discloses all of the elements of the claims, as stated above, the reference fails to teach a portable object being a rug as required by claims 25 and 35, a set of instructions containing specific statements as required by claim 33 and a portable object being soft and pliable as required by claim 37. However, it would have been an obvious matter of design choice to utilize rug as a portable object or to utilize a soft and pliable object as a portable object, since applicant has not disclosed that the use of a rug or a soft and pliable object as a portable object solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the portable object of Sherin, especially since applicants clearly state that the portable object can be any object (page 6, lines 9 and 28-30).

Regarding the specific indicia as required by claim 33, Sherin discloses the claimed invention except for the specific content of indicia (printed matter) set forth in the claim. It would have been obvious to one having ordinary skill in the art at the time

of the claimed invention to provide instructions with the specific indicia of claim 33 since it would only depend on the intended use of the kit and the desired information to be displayed. Furthermore, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with specific type of instructions does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (indicia/writings of claim 33) and the substrate (instructions) which is required for patentability.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laz "The Six Levels of a Happy Marriage" in view of Sherin '106. Laz discloses a system for enabling communication between two parties containing most of the elements of the claims including with respect to claim 32, a set of instructions (considered to be the booklet), a portable object is considered to be the sheet of paper on which the letter (as described on page 17 would be written on). Laz lacks the teaching of a container for packaging, as required by claim 32. However, Sherin discloses a system for fostering cooperative skill and communication skills which teaches that it is known to provide a portable package for storage of materials associated with the system (see abstract, element 12). Thusly, it would have been

further obvious to provide a portable package with the system of Laz for the purpose of storage.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laz "The Six Levels of a Happy Marriage" and Sherin '106, as stated above, and further in view of Lui et al '696. Laz, as modified by Sherin, discloses all the elements of the claims, as stated above, including a first statement describing an action taken by one of the parties (page 17, "...when you say No or We'll see") and a second statement describing a feeling on the part of the speaker (page 17, "How do I feel when...") as required by claim 33.

However Laz fails to explicitly teach a third statement describing a request on the part of the speaker as required by claim 33. Lui discloses a device for aiding communication which teaches that it is known to incorporate a statement describing a request on the part of the speaker in relation to an emotional feeling (element 172, and page 4, last 5 lines of paragraph 0039.

### ***Response to Arguments***

Applicant's arguments with respect to claims 24-27, 32-33 and 35-37 have been considered but are moot in view of the new ground(s) of rejection. It should be further pointed out that the amended language of claim 32 fails to overcome the rejection as set forth in the Office Action mailed on 1/30/2004 and as stated above. The container

Art Unit: 3712

(12) of Sherin houses all of the parts of the kit including instructions and can be carried to various site locations as claimed by the applicants.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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